

Please enter the following amendments and remarks:

### **STATUS OF THE CLAIMS**

Claims 1-26 are pending in the Application.

Claims 1-26 stand rejected by the Examiner.

Claims 19-26 are hereby cancelled.

### **REMARKS**

Reconsideration of the present Application is respectfully requested.

### **Claim Rejections Pursuant to 35 U.S.C. §103**

Claims 2, 4-6, 8-10, 13-14 and 16-18 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Qua (U.S. Patent No. 6,222,909) in view of Gupte et al. (U.S. Patent Application Publication No. 2001/0034225). Claim 3 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Qua and Gupte as applied to Claim 1, and in further view of Oakes et al. (U.S. Patent No. 6,205,342). Claims 7 and 11-12 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Qua and Gupte as applied to the claims above, and in further view of Gibson et al. (U.S. Patent Application Publication No. 2002/0016174). Claim 15 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Qua and Gupte as applied to the claims above, and in further view of Segur (U.S. Patent No. 6,212,550). Claims 19-23 and 25 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Qua and Gupte as applied to the claims above, and in further view of Gillig et al. (U.S. Patent No. 5,127,042). Claim 24 has been rejected

under 35 U.S.C. 103(a) as being unpatentable over Qua, Gupte and Gillig as applied to the claims above, and in further view of Uppaluru (U.S. Patent No. 5,915,001). Claim 26 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Qua, Gupte and Gillig as applied to the claims above, and in further view of Segur. Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *MPEP 706.02(j)*.

Applicant respectfully submits the present Office Action fails to show that Qua teaches a connection to a first server prior to a recording step on a second server. Qua discloses a mechanism that enables a user of a wireless device to store audio notes and subsequently distribute them. The system disclosed by Qua is designed for the quick

recording of comments from a user, for example, to capture a user's thoughts during a conference call.

The present Office Action does not dispute that Qua fails to teach the sequential steps of the method recited in Claim 1. Rather, it is now being argued that by stating in the specification that "numerous modifications and alternative embodiments of the invention would be apparent to those skilled in the art", any configuration of the system taught in Qua is prior art. Although wholly erroneous, if, assuming *arguendo* that the system of Qua were configured to allow for a connection to be made to a first server prior to a recording step on a second server, the system would be inoperable. Thus, Qua teaches away from the present invention.

In Qua, the user *first* records the audio note on the adjunct processor 130 (see Qua, Figure 1). After the audio note is recorded and stored, the user can subsequently forward the audio note via an email system 160 (see Qua, Figure 1). Thus, in the audio note taking system of Qua, connection to the email system via the network only occurs *after* recording of the audio note, and never before.

As recited in Claim 1 of the present invention, a connection is made to a first server prior to the recording step on the second server. Further, the step of selecting an option to send the audio file, as recited in Claim 1, also occurs prior to the recording of an audio file on the second server. Again, Qua teaches the decision to forward an audio note and the options for doing so occurring after the recording of the audio note, and never before such recording step. If Qua were rearranged so as to be "sequentially consistent" with Claim 1, a decision to forward the audio note could not be created or acted upon by the audio note taking mechanism 129. Therefore, Applicant submits that Qua not only fails to teach, or

even suggest for that matter, the sequential method of Claim 1, but actually teaches away from connecting to a first server and selecting an option to send the audio file before connecting to a second server for recording the audio file.

As Claim 1 is patentably distinguishable over the prior art of record, Applicant further submits that Claims 2-17 are similarly distinguishable over the prior art of record, at least by virtue of their ultimate dependency from a patentably distinct base Claim 1.

Claim 18 recites the connecting to an email server and selecting an option to send a voice message *before* the recording of the voice message on a voice response server. As explained above, Qua actually teaches away from connecting to a server before connecting to the server used for recording and storing an audio note. Therefore, each of the references, either separately or in combination, fail to teach or suggest each of the limitations of Claim 18.

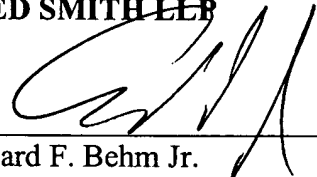
**CONCLUSION**

Wherefore, Applicant believes he has addressed all outstanding grounds raised by Examiner and respectfully submits that the present case is in condition for allowance, early notification of which is earnestly solicited.

Should there be any questions or outstanding matters, Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully Submitted,

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